

## **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and the following remarks.

### **I. Status of Claims**

Claims 1-63, 65-71, 77-93, 95 and 96 were cancelled previously, without prejudice or disclaimer, and claims 64, 73, 75 and 94 are amended presently. Upon entry of this response, independent claim 64 and dependent claims 72-76 and 94 will be pending.

The revision of claim 64, to recite a specific range of molar ratios, is supported by the specification at page 17, lines 16-25 (reciting 1:3 and 1:16); and by Examples 111 and 112, which describe ratios of 1:14 and 2:7. Claim 64 also is revised to recite an intended use, which likewise is supported by Examples 111 and 112 (evidencing unexpected result achieved with applicant's invention in treating dermal inflammation).

Claims 72, 73, and 75 are revised to comport with amended base claim 64. Claim 94 is amended to recite specific molar ratios enumerated in Examples 111 and 112. The phrase "1-glyceryl monocaprylate" is added to claim 94 to ensure proper antecedent basis with respect to the parent claim, thereby correcting a typographical error introduced via the response filed October 30, 2009. The examiner noted this error at page 3 of the Action.

The foregoing changes do not introduce impermissible new matter, and they also comport with the previous election of group and species. The changes are made solely to advance prosecution, not in acquiescence to any rejection.

### **II. Rejection under 35 U.S.C. § 112, second paragraph**

The rejection of claim 94 as indefinite is believed to be overcome by the foregoing amendment to that claim. Applicant respectfully requests reconsideration and withdrawal of the rejection, therefore.

### III. Rejection under 35 U.S.C. § 103

Claims 64, 72-76, and 94 are newly rejected over the combination of WO 00/71093 to Crook *et al.* in view of Cornwell *et al.*, “Glyceryl monocaprylate/caprate as a moderate skin penetration enhancer” *Int’l J. Pharmaceutics* 171: 243-255 (1998). According to the Action, the claimed combination of niacinamide with glyceryl monocaprylate would have been obvious in view of (i) Crook's disclosure of vitamin B3 in a high spreading oil plus “emollients,” which, as a category, encompasses 1-monocaprylate, with (ii) Cornwell's teaching of glyceryl monocaprylate/caprate as a skin penetration enhancer. While acknowledging that the art does not teach specific molar ratios, the Action asserts at page 6, in the first full paragraph, that such ratios were readily accessible via routine experimentation.

Applicant traverses the rejection to the extent that it may have been applied to pending claims 64, 72-76, and 94. Applicant has amended the claims in an effort to advance prosecution, without acquiescing to the proffered rationale for rejection.

Notably, the present claims recite (a) specific ratios of the niacinamide with glyceryl monocaprylate and (b) an intended use. Neither these ratios nor the target patient population implicated by the intend use is suggested or enabled by the Crook/Cornwell combination. Moreover, because efficacy in treating dermal inflammation is not contemplated by the cited references, the prior art of record evidences no reason for the skilled artisan to have formulated or tested any composition as presently claimed. Accordingly, the Office has not shouldered its burden to establish the *prima facie* case of obviousness.

Even were a *prima facie* case in evidence, which is not the case, it would be rebutted by applicant's showing of the unexpected results mentioned above. Unexpected results are objective indicia of non-obviousness that “is not just a cumulative or confirmatory part of the obviousness calculus but constitutes independent evidence of nonobviousness” that must be given full consideration. *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365, 86 U.S.P.Q.2d 1196 (Fed. Cir. 2008).

In particular, Examples 111 and 112 demonstrate results, which would have surprised the skilled artisan, in treating dermal inflammation via a composition of glyceryl monocaprylate with niacinamide in molar ratios of 2:7 (Compound 107) or 1:14 (Compound 51). Furthermore, this

evidence of unexpected results is commensurate, by at least two measures, with the scope of the present claims.

Firstly, all of the claims recite the intended use of “treatment of dermal inflammation,” which use is evidenced in the aforementioned examples. Secondly, the claims and the proffered evidence suitably match up in compositional terms.

In the latter regard, Examples 111 and 112 disclose the molar ratios of 2:7 and 1:14, respectively, while independent claim 64 states that component (i) and component (ii) are present in a molar ratio of between about 1:3 and 1:16. Additionally, dependent claim 94 recites the specific ratios of 1:14 *or* 2:7.

Claim 94 thus tracks the proffered evidence in scope. The range of 1:3 to 1:16, prescribed in claim 64, not only is narrower than the ratio of 1:14 - 14:1, to which the examiner objected previously (Office action at page 7), but also is nearly coincident with the range delimited by the exemplified 2:7 and 1:14 values.

Applicant would only add that *commensurate* in this context does not connote a strict identity. For instance, MPEP § 716.02(d) cites *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979), for the proposition that the “nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof.”

The PTO’s reviewing court in *Kollman* overturned a board’s “commensurate in scope” decision, finding that a range of 1:1 to 4:1 *was* commensurate with evidence of unexpected results associated with ratios of 2:1 and 4:1, respectively. 595 F.2d at 56. If the *Kollman* evidence for a 2:1 ratio is probative vis-à-vis a claim with a recited 1:1 ratio, then the present recitation of a 1:3-to-1:16 range likewise does no more than “reasonably extend” the evidence of unexpected results at 2:7 and 1:14. That is, an extension of data from 2:7 to 1:3 and from 1:14 to 1:16 is less than the 2:1-to-1:1 extension found “commensurate” in *Kollman, supra*.

In view of the foregoing, applicant submits that claims 64, 72-76, and 94 are not obvious within the meaning of Section 103. Accordingly, the rejection should be withdrawn.

**CONCLUSION**

Favorable reconsideration of this application is requested. Examiner Karol is invited to contact the undersigned directly, should she feel that any issue warrants further consideration.

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 C.F.R. §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, then applicant hereby petitions under 37 C.F.R. §1.136 for such extension and authorizes payment of the relevant fee(s) from the deposit account.

Respectfully submitted,

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